



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akira ISHII

Group Art Unit: 2625

Application No.: 10/667,382

Examiner: VO, Q.

Filed: September 23, 2003

Docket No.: 117231

For: IMAGE FORMING APPARATUS AND METHOD THEREOF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the February 6, 2008 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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REMARKS

Claims 1-16 are pending in this application. This review is requested for the following reasons.

I. The Drawings Do Not Present New Matter

The Office Action, on page 2, objects to Fig. 14 as allegedly presenting new matter. This objection is respectfully traversed.

Applicant has clear support for the amendments made to Fig. 14 in the December 11, 2007 Amendment at at least pages 12 and 13 of the specification. During the February 25 telephone conference, Applicant's representative presented the above argument to the Examiner. The Examiner agreed to withdraw the objection to the drawings.

II. Claim 16 Should Be Rejoined

The Office Action, on page 2, indicates that claim 16 is withdrawn from consideration. This requirement is respectfully traversed.

The Office Action asserts that claim 16 is directed to another species directed to Fig. 14. Fig. 14 was amended in the December 11 Amendment only to clarify features already recited in pending claims 1-15. Further, claim 16 added in the December 11 Amendment was added only to clarify features already recited in claims 1 and 13. Claim 16 recites, among other features, a first-color halftone screen and a second-color halftone screen. Fig. 14 clearly supports the combination of features recited in claim 16. As discussed above, Fig. 14 is directed to the subject matter recited in pending claims 1-15. In this regard, the Office Action has not established that Fig. 14 presents an independent Species. As such, withdrawal of the Election of Species Requirement is respectfully requested.

III. The Pending Claims Comply with the Enablement Requirement

The Office Action, on page 3, rejects claims 1-15 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Office Action asserts that it is not possible to have first vectors, each vector being either one of two screen vectors and a spatial frequency domain defined by basis vectors in two directions of a halftone dot pattern in the first-color or second-color halftone screen, are parallel to each other, and second vectors, each being the other one of the two screen vectors, are not parallel to each other, as recited in claims 1 and 13. Claim 16 recites similar features. The Office Action, however, fails to properly interpret the plain language of the pending claims. Applicant has clear support for these features in Fig. 14 and pages 12 and 13.

Claims 1 and 13 recite, among other features, a first-color halftone screen and a second-color halftone screen in said screen set satisfy a relationship that first vectors, each being either one of two screen vectors in a spatial frequency domain defined by basis vectors in two directions of a halftone dot pattern in the first-color or second-color halftone screen, are parallel to each other, and second vectors, each being the other one of the two screen vectors, are not parallel to each other.

Regarding the rejection under 35 U.S.C. §112, first paragraph, the test for compliance with this section, as stated in MPEP §2164.01, quoting *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation" (emphasis added). This standard is clearly met with regard to the above features.

In asserting the above features to be confusing and/or not enabled, the Office Action misconstrues the plain language of the claim and further misconstrues the claim language in light of the specification. As argued in the December 11 Amendment, the plain meaning of

the above-quoted features is a first-color halftone screen (see, *e.g.*, Fig. 14(a)) and a second-color halftone screen (see, *e.g.*, Fig. 14(b)) in said screen set satisfy a relationship that first vectors, *e.g.*, Wa2 and Wb2, each being either one of two screen vectors in a spatial frequency domain defined by basis vectors in two directions of a halftone dot pattern in the first-color or second-color halftone screen, are parallel to each other, and second vectors, *e.g.* Wa1 and Wb1, each being the other one of the two screen vectors, are not parallel to each other.

With reference to Figs. 14(a) and (b), two half tone screens, *e.g.*, 200a and 200b, are depicted with parallel screen vectors, *e.g.*, Wa2 and Wb2. Further, Applicant's specification clearly discusses that screen vectors Wa1 and Wb1 are not parallel, in accordance with the features recited in claims 1 and 13. Figs. 14(a) and (b) have been amended for clarity.

IV. The Pending Claims Are Definite

The Office Action, on page 3, rejects claims 1-15 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. This rejection is respectfully traversed.

The Office Action applies essentially the same reasoning as detailed above in rejecting these claims. As discussed above, Fig. 14 clarifies the relationship of features recited in claims 1 and 13 and described on pages 12 and 13 of Applicant's disclosure as filed.

Regarding the rejection under 35 U.S.C. §112, second paragraph, the test for compliance with this section, as stated in *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994) is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *See, also, In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph, is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. *See, also, In re*

Warmerdam, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). This standard is met with respect to the above-described features.

V. Conclusion

In view of the foregoing, Applicant respectfully requests that the Review Panel review the substance of the February 6, 2008 Final Rejection in light of the above remarks.

Applicant believes that upon such review, the Review Panel will determine that the Office Action's formal rejections of claim 1-15 and the Election of Species Requirement are improper. In this regard, favorable reconsideration and prompt allowance of claim 1-15, in addition to rejoinder and allowance of claim 16, are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicant's undersigned representative.